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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,552	11/25/2003	Jean-Louis Gueret	NONY 3.0-015	5845
530 7590 05/19/2008 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER RUNNING, RACHEL A				
ART UNIT		PAPER NUMBER		
3732				
MAIL DATE		DELIVERY MODE		
05/19/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/721,552

**Applicant(s)**

GUERET, JEAN-LOUIS

**Examiner**

RACHEL A. RUNNING

**Art Unit**

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-32, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anakama (Japanese Patent No. 55-136409) in view of Gueret (United States Patent No. 5,918,994).

Anakama discloses a device comprising a rod 2 having a brush 3 affixed to one end with a core and bristle carrying portion. The bristle carrying portion forms an angle of greater than zero degrees relative to the longitudinal axis of the rod. The device further includes a receptacle adapted to receive the rod and brush. As noted in the claims the brush is "slightly tilted" and thus only encompassing a small angle will not touch the inner wall of the receptacle when in the assembled condition. Anakama discloses the claimed invention except for the brush comprising a twisted wire core and the specific angle the bristle carrying portion makes relative to the longitudinal axis of the rod. Gueret discloses that it is old and well known in the art to make mascara brushes with a twisted wire core. Gueret further discloses various mascara brushes having non-circular cross sections; longitudinal ribs; plane surfaces; concave surfaces; constant cross sections; varying cross sections; and cross sections that vary in size, but not shape. Because both Anakama and Gueret disclose application brushes, it would

have been obvious to one skilled in the art to substitute the twisted wire core brush of Gueret for the brush of Anakama in order to achieve the predictable result of manufacturing an applicator brush (*KSR International v. Teleflex Inc.*, 82 USPQ2d 1385 (2007)). It would have been further obvious to one having ordinary skill in the art at the time the invention was made to have the bristle carrying portion make an angle of less than 20 degrees relative to the longitudinal axis of the rod, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In *re Aller*, 105 USPQ 233. Regarding claims 2-4, 12-15, 19-28, it would have been obvious to one skilled in the art to form the brush of Anakama with the bristles forming an envelope having non-circular cross sections; longitudinal ribs; plane surfaces; concave surfaces; constant cross sections; varying cross sections; and cross sections that vary in size, but not shape in view of Gueret in order to obtain a make-up which is full-bodied, regular, elongated and curls. Regarding claims 16-18, it would have been obvious to one of ordinary skill to make the core of twisted wire having either a right or left hand pitch, as it is old and well known in the art to make mascara brushes with a twisted wire core having either a right or left hand pitch. Regarding claim 35, it appears as though the wiper member would have a circular cross-section since the rod has a circular-cross section, however, it would have been an obvious matter of design choice to have the wiper be of a circular-cross since applicant has not disclosed that the wiper of any other cross-section solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any cross-sectional wiper.

### ***Response to Arguments***

Applicant's arguments filed February 19, 2008 have been fully considered but they are not persuasive.

In response to applicants argument that Anakama does not teach or suggest the twisted-wire core being bent such that substantially all points of the bristle-carrying portion form an angle greater than 0 degrees and less than about 20 degrees, applicant states that the angle shown in Figure 1 is on the order of 30 degrees, however, Figures are not to be taken to scale (MPEP 608.02), further it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

In response to applicant's argument that Anakama does not disclose a twisted-wire core, it is noted that Examiner acknowledged that Anakama does not disclose a twisted-wire core, but was modified with Gueret to substitute the twisted wire core brush of Gueret for the brush of Anakama in order to achieve the predictable result of manufacturing an applicator brush (*KSR International v. Teleflex Inc.*, 82 USPQ2d 1385 (2007)).

In regards to applicant's argument that Anakama does not teach or suggest the brush being spaced from the inner wall in the assembled condition, however, it is noted in the claims the brush is "slightly tilted" and thus only encompassing a small angle will not touch the inner wall of the receptacle when in the assembled condition.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL A. RUNNING whose telephone number is (571)272-1917. The examiner can normally be reached on Monday-Friday 7:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robyn Doan/  
Primary Examiner, Art Unit 3732

/Rachel A. Running/  
Examiner  
Art Unit 3732